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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,962	10/18/2000	Bore Klemets	AN05975/3151PIUS	3234

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Lainie E Parker
Akzo Nobel Inc
Intellectual Property Department
7 Livingtone Avenue
Dobbs Ferry, NY 10522-3408

EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 01/31/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/691,962

Applicant(s)
Klemets et al.

Examiner
José A. Fortuna

Art Unit
1731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 16, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 20) ☐ Other:

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in European Patent Office on April 27, 1998. It is noted, however, that applicant has not filed a certified copy of the European application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear at what point the conductivity of the slurry is measured, i.e., before or after the addition of the retention aid?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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5. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Nagarajan et al., EPO 0 805 234 A2 further evidenced by Satterfield et al., US Patent No. 5,755,930.

Regarding Claims 1-20, Nagarajan et al. teach a process of making paper in which a cationic organic polymer containing an aromatic group, same as the one claimed, is added to a papermaking pulp along with an anionic inorganic particle(s), such as bentonite or silica sol, see abstract. The monomers conforming the cationic additives, shown by the reference, are the same as claimed, see abstract and pages 4-5. Even though Nagarajan et al. are silent as to the conductivity of the pulp, this property is inherent to their invention since modern papermaking process are highly closed and recycled water are used in the papermaking operation, which contaminants increase the conductivity of the pulp to the claimed levels. Evidence is shown by Satterfield et al. in column 4, lines 41-67, where they teach that the conductivity of the recycled water is usually above 3,000 micro Siemens.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7, 11, and 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearson, US Patent No. 5,466,338 further evidenced by Satterfield et al.

Pearson teaches the use of dispersion of polymers for coated broke treatment. The polymers disclosed by Pearson are the same ones used in the present invention and therefore, it would be expected the same increase of the strength of the web, since the addition amounts are within the ranges disclosed in the specification of the claimed invention, see abstract and column 4, line 59 through column 5, line 25. Even though Pearson is silent with respect to the

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conductivity of the pulp, this property is inherent to his invention, since it is well known that modern paper machines white water is recycle back to the pulp making process and also that coated broke contains salts and dissolved solids that contribute to the increase of the charge of the pulp increasing thus the conductivity of the slurry. Note that Satterfield et al. teach that in the recycling of the white water the conductivity of the pulp slurry increases in ranges over 3,000 micro Siemens, see above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Process for the production of paper."


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to José Fortuna, whose telephone number is (703)305-7498. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman, can be reached on (703)308-3837. The fax number for this group is (703)305-7115.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0661.

When filing a FAX in group 1730, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

José A. Fortuna
January 23, 2002


JOSE FORTUNA
PRIMARY EXAMINER
ART UNIT 1731